

### **REMARKS**

Claims 1-27, 29-34, 36-54, 57-59, 63-65, 110-113 and 118-121 are pending in the present Application. Claims 1, 63 and 64 have been amended, with such amendments being of a clarifying nature and not made for purposes of distinguishing the claims over the prior art. Accordingly, no new matter has been added by the foregoing amendments.

#### ***Examiner Interview***

Applicants and the undersigned thank Examiner Tran for courtesies extended during a telephone Interview conducted October 6, 2010. During the Interview, Applicants' representatives and the Examiner discussed the procedural history of the case and the outstanding rejection. Examiner Tran suggested several claim amendments that would advance prosecution. Such suggestions have been incorporated into the claims as amended herein. The remarks presented herein are consistent with the distinctions over the prior art discussed during the Interview.

#### ***Entry of Rule 116 Response***

Entry of the amendments herein are respectfully requested because such amendments, in combination with the remarks, render moot the outstanding rejections under 35 U.S.C. § 103, and thus resolve all issues raised by the Examiner in the Final Office Action. Also, at the telephone Interview, the Examiner indicated that entry of the response would be permitted and the finality of the rejection would be withdrawn. In addition, the Amendment places the application in condition for allowance or in better form for appeal by materially simplifying the issues and does not result in a net addition of claims to the application. No new matter has been added to this application by the Amendment.

#### ***Insufficiency of Examiner's Office Action***

In previous Amendments and Responses, Applicants have repeatedly demonstrated Examiner's errors in previous Office Actions in this application. However,

the Examiner continues to maintain rejections, without explanation, that are clearly not supported by the cited prior art. For example, the Examiner has grouped the rejection of independent claims 33, 34 and 36 with the rejection of independent claim 1. However, independent claims 33, 34 and 36 recite features that are distinct from those of claim 1 and cannot be rejected by simply referring to the rejection of claim 1. Claim 33 requires a "determination...that the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement," whereas claim 1 recites no such feature. Despite Applicants' remarks discussing such shortcomings in the Examiner's Office Actions, the Examiner continues to ignore the Applicants' arguments while maintaining the unsubstantiated rejections. In the event that the Examiner continues to maintain the present rejections, Applicants respectfully request that sufficient basis and explanation for rejections of each of the claims be provided, as required by M.P.E.P 707.07(g).

#### ***Response to Examiner's Arguments***

The Examiner argues, "Slezak teaches that during displaying a must view program, the system will ignore a changing viewing operation that interrupts the display of the must view program...." Office Action, page 20. The Examiner also argues, "the concept that forces a viewer to watch a unwanted program or must view program is well known in the art and that will motivate a practitioner in the art to modify the system of Unger ....to ignore the end of trick play event mode input by the user during displaying an alternative advertisement." Id.

By arguing that the alternative advertisement in claim 1 is "must view content," the Examiner demonstrates a basic misunderstanding of the claimed subject matter. In the proposed combination of Slezak and Unger, the alternative advertisements of Unger would be played in their entirety as "must view content." However, in claim 1, the alternative ad is displayed until the end of the recorded advertisement (not the end of the alternative advertisement). The amount of time it takes to trick play the underlying recorded advertisement effectively controls how long the alternative advertisement will be presented. This is because the alternative advertisement is not "must view," as the

Examiner contends. In claim 1, if the recorded advertisement finishes being trick-played faster than the time it takes to present the entire alternative advertisement, presentation of the alternative advertisement may not be completed in its entirety. In contrast, Slezak requires presenting the “must view” (i.e., the original programming) content to its conclusion. Thus, because in Slezak the must view content controls the waiting of the trick play command, the alternative ad of Unger would be displayed **until the end of the alternative advertisement – not until the recorded advertisement as in claim 1.**

Applicants also disagree with the Examiner that simply identifying the concept of forcing a viewer to watch an unwanted program would motivate combining Unger with Slezak to force the viewer to watch an alternative ad that is presented while a recorded ad is being trick-played, **even though the user has requested to view the recorded advertisement.** Applicants have repeatedly pointed out to the Examiner that there is nothing in Unger that would suggest making the tagged i-frames “must-view.” In fact, because in Unger most frames of the advertisement are skipped in favor of the tagged subset of frames from that same ad, Unger would prefer to return the user to the real advertisement as soon as possible. Thus, the Examiner cannot simply assert that the tagged i-frames of Unger are must-view content. There is simply no such teaching anywhere in either Unger or Slezak to support such an assertion.

To support the combination of Unger and Wang, the Examiner argues that “the examiner relies on teaching of disabling and enabling between various playing modes of the recorded contents to maintain playing a specified content portion or fast forwarding another specified content portions until a beginning of the specified portion as taught by Wang to modify the Unger apparatus....” Office Action, page 21. However, the Examiner has overly generalized the teaching of Wang. Wang does not teach enabling or disabling changing the playing mode of changing the playing mode of any content. Instead, Wang clearly teaches that skipping or fast forwarding of the original (recorded) advertisement may be disabled. There is no reason to apply the teaching of disabling the skipping of original advertisements of Wang to the teaching of presenting alternative advertisements as in Unger, as the Examiner asserts.

***Claim Rejection – § 103(a)***

The Examiner has rejected claims 1-2, 20-27, 29-34, 36-54, 59, 63-65, 110-113 and 118-121 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,909,837 to Unger (“Unger”) in view of U.S. Patent No. 6,006,257 to Slezak (“Slezak”). Applicants respectfully traverse this rejection.

The Combination of Unger and Slezak is improper.

**1) Impermissible Hindsight**

Applicants respectfully submit that the combination of Unger with Slezak is improper because the Office Action relies on information gleaned solely from Applicants’ specification. MPEP § 2142 states that “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of **the facts gleaned from the prior art**” (emphasis added). “Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and **does not include knowledge gleaned only from Applicant’s disclosure**, such a reconstruction is proper” (MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971), (emphasis added).

In the present case, the Office Action relies on reading “alternative advertisements” as must-view content to allegedly support the combination of Unger with Slezak. The problem with this interpretation, however, is that **neither Unger nor Slezak describes the alternative advertisements as being must-view**. In fact, because Slezak teaches that the original content is must view content, Slezak would not allow for the presentation of an alternative ad in the first place. Such teachings are only present in Applicants’ disclosure. Due to the lack of teaching or suggestion that alternative advertisements are “must view” in the cited art and the fact that such teaching is only present on the record in Applicants’ specification, it logically follows that requiring the subscriber to finish watching an alternative advertisement has been improperly gleaned from Applicants’ own specification and that the combination of Unger and Slezak is an

exercise of impermissible hindsight. Accordingly, it is respectfully submitted that the combination is improper and respectfully requested that the rejection be withdrawn.

## 2) Frustrated Purpose

Applicant respectfully submits that the combination of displaying tagged i-frames taught by Unger with ignoring trick-play events in Slezak is improper. Such a combination would result in a bizarre situation where the alternative ads of Unger could never possibly be presented, because the teaching of Slezak would cause the trick play initiation command to be “waited” until the original ad has been displayed. The display of alternative advertisements is important to Unger and the removal thereof would frustrate the purpose of the system discussed therein.

Furthermore, even if, as the Examiner argues, Slezak may be read to ignore the **end** of trick-play events – which it may not – in Unger, the advertisers desire the user to view the entire advertisement, not trick play through the ad. Although the advertiser in Unger desires to present the entire commercial message to the viewer, the advertiser is willing to settle for the viewer receiving an abbreviated commercial message (see Unger, column 6, lines 47-53). Thus, by ignoring the end of trick-play events, Unger’s stated purpose of, “protecting the broadcaster’s source of revenue by providing the advertiser with a means of reaching potential customers **with, at least**, an abbreviated advertising message,” would be frustrated.

MPEP §2143.01(V) states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” (emphasis added). “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” (emphasis added).

As such, Applicants respectfully submit that a person of ordinary skill in the art would not have a reason to combine these features and that further, the combination thereof would frustrate the principle of operation of Unger. Therefore, Applicants respectfully submit that the proposed combination of Unger and Slezak is improper and request that the rejection be withdrawn.

The Combination of Unger and Slezak does not teach each and every element of claim 1.

The combination of Unger and Slezak does not teach or suggest, “registering the detected end of the trick play event and continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement,” as recited in independent claim 1. In Unger, if the viewer stops the trick play, the viewer is returned to normal play of the underlying ad, “if a tagged frame is detected, that frame is then output by recorder/playback device and displayed on the television set or monitor as a static image that is maintained **until the fast forward operation is terminated.... The static image is replaced when normal playback is resumed upon termination of the fast forward operation.**” Column 5, lines 50-58. Since the advertiser desires that the user view the underlying advertisement in its entirety, continuing to trick play the alternative advertisement after the user indicates that he desires to resume regular playback during an advertisement is counter-intuitive and non-obvious to the teachings of Unger, and contrary to what is recited in claim 1.

Similar to Unger, Slezak’s system endeavors to have the user watch an entire commercial message. The point of Slezak’s invention is forcing a viewer to view an entire advertisement without skipping or fast forwarding. For example, Slezak teaches:

If the viewer is viewing a "must view" video, the process proceeds to step 2022 where it is determined whether the command requests a forward shift in the current video stream or an entirely new video stream. If command does request a forward shift or change from the current video stream, the process is waited until the current "must view" video stream is completed in step 2024. (Slezak, column 9, lines 50-56)

Therefore, Slezak does not support the notion of registering the detected end of the trick play event and continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement.” Slezak instead endeavors to prevent fast-forward operations in the first place. That is, Slezak is not concerned with the end of a trick-play event, but rather prevents the trick-play event from occurring in the first place. Ultimately, neither Unger nor Slezak address the desirability of continuing to trick play the recorded advertisement.

In the above quoted section, when Slezak teaches that the “process is waited,” it is not a trick play process itself that is being “waited.” Slezak instead detects an initiation of a fast forward command or a channel change, not “an end of the trick play event.” Therefore, Slezak cannot be said to teach “detecting an end of the trick play event prior to the end of the recorded advertisement;” and “registering the detected end of the trick play event and continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement;” as recited in claim 1.

Slezak also does not teach “displaying the alternative advertisement” while continuing to trick play. Instead, Slezak teaches that “the process is waited until the current ‘must view’ video stream is completed...” This is not for a trick play event, nor is it in response to the ending of a trick play event. Further, this is not an alternative video (derived from the underlying recorded advertisement) that is being played, but instead the “must view” video that is part of the original presentation stream.

The Examiner attempts to get around this issue in the combination by arguing that Slezak teaches, “the system will ignore a changing viewing operation that interrupts the display of the must view program.” Office Action, page 20. However, this is an over-generalization of the teachings of Slezak. Slezak is explicit in the fact that it is looking for whether a “command requests a forward shift in the current video stream or an entirely new video,” and only then ignores the command. Thus, it is clear that Slezak only teaches ignoring the **start of a trick-play event**, and not ignoring any type of command, as the Examiner claims.

Further, Applicants point out that the presently claimed system does not ignore the user's input, instead, it registers the command and returns to the programming as soon as the trick-played advertisement ends. This is substantially different from Slezak, which completely ignores the user's command. Second, Slezak teaches completely ignoring a user's input to force the user to watch the "must-view video" until the end. There is no reason to believe that this teaching can be applied to trick-played advertisements such as those in Unger. Thus, there is no motivation to combine Slezak and Unger in the way suggested by the Examiner.

Although the Examiner states that Unger only "fails to teach a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed," Unger also fails to teach continuing to display the alternative advertisement as recited in claim 1. Therefore, the combination of Unger and Slezak fails to teach all aspects of independent claim 1.

Independent claim 33 recites "displaying the alternative advertisement to the subscriber, wherein said displaying includes displaying the alternative advertisement if a determination is made that the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement." However, in the Final Rejection, the Examiner does not even attempt to address whether this feature is taught by the prior art. Specifically, the Examiner did not attempt to address all aspects of claim 33 (Applicants have previously informed the Examiner of this deficiency, see Request for Reconsideration, filed January 26, 2010, page 16-17).

Moreover, Applicants respectfully submit that there is nothing in the prior art of record that teaches making a determination if "the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement," as recited in independent claim 33. None of Unger, Slezak, or the combination thereof teach or suggest determining the time period needed to trick play through the recorded advertisement and whether the alternative advertisement can be displayed during that period. Therefore, independent claim 33 is patentable over the proposed combination of Unger and Slezak.



Independent claim 36 recites, “pausing the trick play event until said displaying alternative advertisement is complete if additional time is required to display entire alternative advertisement based on the point in advertisement that the trick play event occurs.” Independent claim 63 recites, “means for automatically controlling the fast forward event, wherein if said means for detecting detects the end of the fast forward event prior to end of the recorded advertisement, said means for automatically controlling will continue to fast forward the recorded advertisement until the end of the recorded advertisement, and said means for displaying will continue to display the alternative advertisement until the end of the recorded advertisement.” For similar reasons as discussed in relation to claim 1, independent claims 36 and 63 are patentable over the combination of Unger and Slezak.

Additionally, many of the dependent claims were not properly addressed by the Examiner and provide additional patentable distinctions over the combination of Unger and Slezak. For example, dependent claims 42, 43, 53, and 113 contain additional aspects that are clearly distinct from the proposed combination. Dependent claims 42 and 113 recite that “the processing rules are specific to the recorded advertisement.” The processing rules provided by Unger are not specific to the recorded advertisement. Instead they are generic rules, simply instructing the system to display tagged I-frames (see Unger column 5, lines 39-66). Furthermore, the Examiner groups his rejection of claim 43 with claims 42 and 113, which is illogical. In contrast to claims 42 and 113 which recite that the rules are specific to the ad, claim 43 recites that “the processing rules are specific to the subscriber.” The combination of Unger and Slezak do not provide subscriber specific processing rules, nor does the Examiner address this aspect of the claims.

Dependent claim 53 recites that “the alternative advertisement is not related to the recorded advertisement.” In Unger, the displayed I-frames are more than just related to the recorded advertisement - they are part of the recorded advertisement. Therefore, Unger cannot be said to teach that “the alternative advertisement is not related to the recorded advertisement.”

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 as being unpatentable over Unger in view of Slezak, in further view of U.S. Patent No. 4,845,564 to Hakamada ("Hakamada"). For the same reasons discussed above, the combination of Unger and Slezak does not teach or suggest all features of independent claims 1 and 63. Hakamada does not teach or suggest these missing elements. Accordingly, independent claims 1 and 63 are allowable over Unger in view of Slezak and further in view of Hakamada. Therefore, dependent claims 3, 4, 7-14, 17-19 and 57-58 are allowable at least by their dependency on claims 1 and 63, respectively.

The Examiner has rejected claims 5, 6, 15 and 16 as being unpatentable over "Unger in view of Hakamada et al (4,845,564) as applied to claim 1-3 and 14 above, further in view of Canfield et al (5,031,044)." Office Action, page 11. Applicants respectfully submit that since claims 5 and 6 depend from claim 4, which depends from claim 3, and claim 3 depends from claim 1, the Examiner's rejection of claims 5 and 6 is improper because it does not include Slezak. Similarly, because claims 15 and 16 depend from claim 14, which depends from claim 1, the rejection is improper for the same reason. Claims 5, 6, 15 and 16 should be rejected over Unger in view of Slezak and Hakamada and further in view of U.S. Patent No. 5,031,044 to Canfield ("Canfield"). However, for the reasons discussed above, the combination of Unger, Slezak and Hakamada does not teach or suggest all features of independent claim 1. Canfield does not teach or suggest these missing elements. Accordingly, independent claim 1 is allowable over Unger in view of Slezak and Hakamada and further in view of Canfield. Therefore, dependent claims 5, 6, 15 and 16 are allowable at least by their dependency on claim 1.

Claims 1-2, 20-27, 29-34, 36-54, 59, 63-65, 110-113 and 118-121 are rejected under 35 U.S.C. §103(a) as being unpatentable over Unger in view of U.S. Patent Application Publication No. 2002/0191950 to Wang ("Wang").

Applicants respectfully submit that the combination of Unger and Wang would be inoperable. Unger allows presenting an alternative advertisement to a user during a trick-play event; however, Unger allows stopping the alternative advertisement to return to the

original advertisement. Wang, on the other hand, completely *prevents* the skipping of ads by disabling commands such as fast-forward. MPEP § 2143.01(V) states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” (emphasis added). “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” (emphasis added). Thus, there is no motivation to combine Unger and Wang in the way proposed by the Examiner because doing so would result in a system that is unsatisfactory for the intended purpose of presenting trick-play ads as described in Unger. As such, the proposed combination of Unger and Wang is improper.

Moreover, unlike the proposed combination of Unger and Wang, the presently claimed subject matter does not in any way “enable or disable” the skipping functions of the video recording and playback device. Instead, when the presently claimed system receives a command to stop a trick-play, it registers the command but completes playing the alternate advertisement. Once the trick-played advertisement is completed, the system automatically switches to the recorded content. That is, in the presently claimed system, the user is not required to press a button to complete the requested command after the advertisement has finished playing. Conversely in Wang, a user’s button press on a remote would not be registered and the user would be required to press the same button again when the commercial is completed.

Further, Wang does not teach, “registering the detected end of the trick play event and continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement,” as recited in claim 1. Because Wang prevents all skipping of advertisements, a trick-play could not be continued as claimed. Ultimately, neither Wang nor Unger teaches or suggests continuing trick-playing alternate advertisements. Thus, because the combination of Unger and Wang does not teach each and every element of claim 1, independent claim 1 is allowable

over the cited prior art. Independent claims 33, 34, 36 and 63-65 are allowable for reasons similar to those discussed with respect to claim 1. Dependent claims 2, 20-27, 29-32, 37-54, 59, 110-113 and 118-121 are allowable based at least on their dependency on claims 1, 34, 36, and 63, respectively.

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 as being unpatentable over Unger in view of Wang and further in view of Hakamada. For the same reasons discussed above, the combination of Unger and Wang does not teach or suggest all features of independent claims 1 and 63. Hakamada does not teach or suggest these missing elements. Accordingly, independent claims 1 and 63 are allowable over Unger in view of Wang and further in view of Hakamada. Therefore, dependent claims 3, 4, 7-14, 17-19 and 57-58 are allowable at least by their dependency on claims 1 and 63, respectively.

The Examiner has rejected claims 5, 6, 15 and 16 as being unpatentable over “Unger in view of Wang as applied to claim 1-3 and 14 above, further in view of Canfield et al (5,031,044).” Office Action, page 19. Applicants respectfully submit that since claims 5 and 6 depend from claim 4, which depends from claim 3, and claim 3 depends from claim 1, the Examiner’s rejection of claims 5 and 6 is improper because it does not include Hakamada. Similarly, because claims 15 and 16 depend from claim 14, which depends from claim 1, the rejection is improper for the same reason. Claims 5, 6, 15 and 16 should be rejected over Unger in view of Wang and Hakamada and further in view of Canfield (“Canfield”). However, for the reasons discussed above, the combination of Unger, Wang and Hakamada does not teach or suggest all features of independent claim 1. Canfield does not teach or suggest these missing elements. Accordingly, independent claim 1 is allowable over Unger in view of Wang and Hakamada and further in view of Canfield. Therefore, dependent claims 5, 6, 15 and 16 are allowable at least by their dependency on claim 1.

*Conclusion*

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-27, 29-34, 36-54, 57-59, 63-65, 110-113 and 118-121, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 10/27/10

By: 

Andrew W. Spicer  
Registration No. 57,420  
Carlineo, Spicer & Kee, LLC  
2003 South Easton Road, Suite 208  
Doylestown, PA 18901  
267-880-1720

Customer No.: 81712